



Attorney Docket No. 71417/49138

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Kearney et al.

Art Unit: 1636

U.S.S.N.: 09/961,128

Examiner: Celine Qian

FILED: September 21, 2001

FOR: ENDOTHELIAL CELL MITOGEN BIOASSAY

Commissioner for Patents
Washington, D.C. 20231

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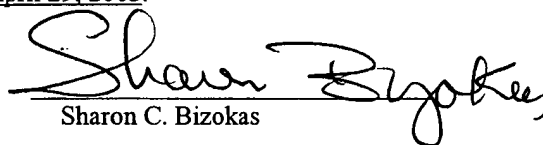
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CERTIFICATE OF MAILING

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231 on April 29, 2003.

By:


Sharon C. Bizokas

TRANSMITTAL LETTER

Sir:

Transmitted herewith for filing in the above-referenced patent application are the following documents:

1. Response to Election/Restriction Requirement (2 pages);
2. Copy of Office Action (4 pages);
3. This transmittal letter (1 page) (x2); and
4. Return postcard.

The Commissioner is hereby authorized to charge any excess fees that may be required, or credit any overpayment to Deposit Account No. 04-1105. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



Kathryn A. Piffat, Ph.D. (Reg. No. 34,901)
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21874

PATENT TRADEMARK OFFICE

Date: April 29, 2003



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#9

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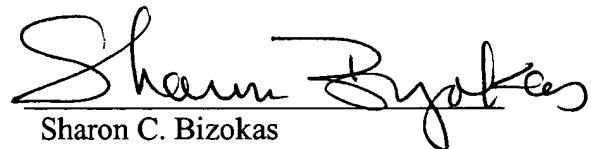
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By:


Sharon C. Bizokas

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

In response to the election/restriction requirement of January 29, 2003, Applicants hereby elect the species of Group II, which presently includes vascular endothelial growth factor (VEGF), as defined on page 4, lines 19-26, and on page 7, line 30, to page 8, line 6, of the specification for the above-referenced application. This election is made with traverse.

Applicants respectfully request reconsideration of the election/restriction requirement as set out in the Office Action. For example, it is believed that no undue burden would be imposed by examination of multiple groups, particularly Groups II, III, and IV. More particularly, searches for Groups III and IV would overlap significantly with a search for Group II.

Applicants note that the Examiner has stated that claims 1, 6-10, and 15-17 are generic. These generic claims and claims dependent thereon are readable on Group II.

The present species election is made solely to comply with the restriction requirement set forth in the Office Action. It should not be construed as a disclaimer or surrender of any subject matter in the application. The right to file one or more divisional or continuation applications on the non-elected species is reserved. It is understood that the Examiner will eventually expand the prior art search to include all species encompassed by the claims.

Applicants believe that no request for an extension of time is required, because this Response is being filed within the specified three (3) month period. If any extension of time is needed, applicants hereby conditionally petition for an extension of time to provide for the possibility that the need for such a petition has been inadvertently overlooked.

Although it is not believed that any additional fees are needed to consider this submission, the Examiner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Respectfully submitted,

Kathryn A. Piffat, Ph.D.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,128	09/21/2001	Marianne Kearney	49138 (71417)	4197

7590 01/29/2003

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DIKE, BRONSTEIN, ROBERTS & CUSHMAN
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Boston, MA 02209

EXAMINER

QIAN, CELINE X

ART UNIT	PAPER NUMBER
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1636

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DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.	Applicant(s)	
09/961,128	KEARNEY ET AL.	
Examiner	Art Unit	
Celine X Qian	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-17 are pending in the application.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: a method for testing a plasmid containing a gene encoding for an endothelial cell mitogen for the ability to produce a biologically active endothelial cell mitogen protein, wherein said gene encode I. acidic and basic fibroblast growth factors, II. vascular endothelial growth factor (VEGF), III. VEGF A, IV. VEGF C, V. epidermal growth factor, VI. transforming growth factor α , VII. transforming growth factor β , VIII. platelet-derived endothelial growth factor, IX. platelet-derived growth factor, X. tumor necrosis factor α , XI. hepatocyte growth factor, XII. insulin-like growth factor.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 6-10 and 15-17 generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celine X Qian whose telephone number is 703-306-0283. The examiner can normally be reached on 9:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Celine Qian, Ph.D.
January 19, 2003

Anne-Marie Falk
ANNE-MARIE FALK, PH.D.
PRIMARY EXAMINER